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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,239	08/20/2001	Paul Brand	P01,0178	3292

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SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, IL 60606-6473

EXAMINER

OROPEZA, FRANCES P

ART UNIT PAPER NUMBER

3762

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,239

Applicant(s)

BRAND ET AL.

Examiner

Frances P. Oropeza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/11/03 (Amendment).
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 10-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date g.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Applicant's arguments regarding the rejection as being anticipated by Johansson et al. are convincing, hence this rejection is withdrawn.

As to the rejection as being unpatentable over Schiff and Hawkins et al., the Applicant amended independent claim 10, overcoming the rejection on record. A new ground of rejection is established in the subsequent paragraphs.

Claim Rejections - 35 USC § 103

2. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff (US 5383913) in view of Hawkins et al. (US 6029089).

Schiff discloses a metal sleeve (48), read as metallic tubular member having a length continuous along an entirety of the length (figure 3), disposed in a housing (30), containing a plurality of interior components (figure 3) to make mechanical and electrical contact with the contact plug (18) (figures 1, 2, 3, and 7). The tubular member is closed by way of a plug (35). The insulating plug (47) has interior elements mounted therein.

As discussed in the previous paragraph of this action, Schiff discloses the claimed invention except the housing being metallic and the tube ends being bonded or welded to the housing

Hawkins et al. teach implantable device component assembly using a metallic housing with the barrel welded or bonded to the housing for the purpose of securing the barrel assembly in the device. It would have been obvious to one having ordinary skill in the art at the time of

the invention to have used metallic housing and bonding or welding the barrel to the housing in the Schiff system in order to simplify the device housing by replacing the cast epoxy connector with a metallic housing and using a weld/ bond to provide firm attachment of the barrel so the device is simplified and hermetically sealed and protected from bodily fluids (figure 3; col. 2 @ 26-47; col. 5 @ 35-45).

The Applicant's arguments filed 12/11/03 have been fully considered, but they are not convincing.

The Applicant argues the Examiner has incorporated the Hawkins et al. reference to teach welding the barrel/ tubular member to the housing. The Examiner disagrees. Hawkins et al. is incorporated in the rejection of record to teach use of a metallic housing, welding the tube ends to the housing, use of a ceramic insulting plug, and ceramic component attachment as noted in the previous paragraphs of section 1 of this action.

In response to the Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant argues Hawkins et al. do not disclose a continuous metal tube as shown in figure 5, but rather sockets (58 and 60), hence the instant invention is not taught. The Examiner disagrees. As detailed in section 1 of this action, Schiff teaches a pacemaker with a metal sleeve (48), read as a continuous metal tube as shown in figure 3. Hawkins et al. is incorporated in the

rejection to teach use of a metallic housing, welding the tube ends to the housing, use of a ceramic insulting plug, and ceramic component attachment.

In response to the Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., components creating insulation problems/ issues) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Applicant appears to argue the female socket taught by Hawkins et al. could not be incorporated in the Schiff reference without encountering insulation difficulties. It is noted the instant invention is taught by the combination of the Schiff and Hawkins et al. references without incorporating the connector bore unit/ female socket taught by Hawkins et al. In addition, the insulating material or body (47) shown in figure 3 appears to address the insulation issue associated with the plug (18) and the metal sleeve (48) (col. 7 @ 51-53) suggested by the Applicant.

Allowable Subject Matter

3. Claims 11-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Information Disclosure Statement

4. The reference EP 0 261 582 A1 included in the information disclosure statement filed 12/11/04 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The copy of the EP 0 261 582 A1 reference sent with the 4/24/01 IDS is not written English and appears to be written in German. The signed information disclosure statement has been placed in the application file, but the EP 0261 582 reference referred to therein has been lined through as it has not been considered.

Statutory Basis

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Friday from 9 a.m. to 5 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

FPO
2/21/04

Angela D. Sykes

**ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**